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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,442	10/02/2003	Manfred Gilbert	LWEP:120US	1582

7590 12/15/2004
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EXAMINER

AMARI, ALESSANDRO V

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/678,442

Applicant(s)

GILBERT, MANFRED

Examiner

Alessandro V. Amari

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/5/2004</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 5 and 6 are objected to because of the following informalities:

Regarding claim 5, lines 1-2, the phrase, "can be partially inserted" is ambiguous because it is unclear whether the phrase following the limitation is part of the claimed invention. Claim 6 inherits the same issue. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakasato US 5,262,891.

In regard to claim 1, Nakasato discloses (see Figures 1, 8) a portable microscope comprising a stand that is constructed from a first housing shell (2) and a second housing shell (3); a height-adjustable microscope stage (8) which is carried by the stand; a base part that closes the first and the second housing shell at the bottom as shown in Figure 1, wherein the microscope stage has a sample support part (7), a guide

part (13), and a base (10) and the base of the microscope stage carries an illumination module (9).

Regarding claim 2, Nakasato discloses that an energy source is provided in the base part of the stand, the energy source being a battery or rechargeable battery as described in column 3, lines 9-34.

Regarding claim 3, Nakasato discloses that a connection socket for an external power supply or for recharging the rechargeable battery is provided on the stand of the microscope as described in column 3, lines 9-34.

Regarding claim 5, Nakasato discloses that the microscope stage can be partially inserted into the stand as defined by the first and the second housing shell, the guide part of the microscope stage sliding inside the stand as described in column 3, lines 9-62.

In regard to claim 9, Nakasato discloses (see Figures 1, 8) a microscope stage for a portable microscope comprising a sample support part (7), a guide part (13) and a base (10) and an illumination module (9) carried by the base.

4. Claims 9, 10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Tandler et al US 6,674,575.

In regard to claim 9, Tandler discloses (see Figures 1, 2) a microscope stage for a portable microscope comprising a sample support part (1), a guide part (13) and a base (A2) and an illumination module (8) carried by the base as described in column 1, lines 63-67 and column 2, lines 1-10.

Regarding claim 10, Tandler discloses an illumination module includes a light-emitting diode that emits white light and is mounted, together with an electronic circuit, proximate the base as described in column 2, lines 30-41. While Tandler et al does not explicitly teach an electronic circuit, this is seen as an inherent teaching of the prior art since it is apparent that an electronic circuit must be present in order for the device to function as intended.

Regarding claim 13, Tandler discloses (see Figure 2) that the sample support part includes a transparent element (1, 2); and a diffusion disk (7) is provided between the illumination module and the transparent element as shown in Figure 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891 in view of Kaczynski et al US 5,315,080.

Regarding claims 4 and 11, Nakasato teaches the invention as set forth above and regarding claim 12, that the energy source being a battery or rechargeable battery as described in column 3, lines 9-34 but does not teach an on/off switch associated with the microscope stage.

Regarding claims 4 and 11, Kaczynski et al does teach (see Figures 1, 2) an on/off switch (21) associated with the microscope stage.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the switch as taught by Kaczynski et al in the microscope of Nakasato in order to protect the objective lenses and all associated components from damage in the event of an uncontrolled specimen collision as described in column 1, lines 57-68 and column 2, lines 1-5 of Kaczynski et al.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891 in view of Schilling et al US 4,565,427.

Regarding claim 6, Nakasato teaches the invention as set forth above but does not teach an elastic element which exerts a return force on the microscope stage in order to pull the microscope stage into the stand is joined to the base of the microscope stage and the stand.

Regarding claim 6, Schilling et al teaches (see Figure 1A) an elastic element (18) which exerts a return force on the microscope stage in order to pull the microscope stage into the stand is joined to the base of the microscope stage and the stand as shown in Figure 1A.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the elastic element as taught by Schilling et al in the microscope of Nakasato in order to provide for rapid and easy action adjustment of the microscope stage.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891 in view of Kapitza et al US 5,781,338.

Regarding claim 7, Nakasato teaches the invention as set forth above but does not teach that the illumination module encompasses a light emitting diode that emits white light.

Regarding claim 7, Kapitza et al does teach (see Figures 2, 3) an illumination module that encompasses a light emitting diode (33a, 33b) that emits white light.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the light emitting diode of Kapitza et al in the microscope of Nakasato in order to provide for a power saving and higher reliability illumination device.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891 in view of Kapitza et al US 5,781,338.

Regarding claim 8, Nakasato in view of Kapitza et al teaches the invention as set forth above and Kapitza teaches an electronic circuit but does not teach that the base of the microscope stage, the light-emitting diode, and an electronic circuit together constitute illumination module and are a preassembled component, and the base, the guide part, and the sample support stage part are adhesively bonded to one another. While Kapitza et al does not explicitly teach an electronic circuit, this is seen as an inherent teaching of the prior art since it is apparent that an electronic circuit must be present in order for the device to function as intended. It would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the base, guide part and sample support stage together since it has been held that making in one piece which has formerly been formed in multiple pieces involves only routine skill in the

art. One would have been motivated to bond the base, guide part and sample support stage together in order to permanently and rigidly bond the components together. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891 in view of Kapitza et al US 5,781,338.

Regarding claim 10, Nakasato teaches the invention as set forth above but does not teach that the illumination module encompasses a light emitting diode that emits white light together with an electronic circuit.

Regarding claim 7, Kapitza et al does teach (see Figures 2, 3) an illumination module that encompasses a light emitting diode (33a, 33b) that emits white light. While Kapitza et al does not explicitly teach an electronic circuit, this is seen as an inherent teaching of the prior art since it is apparent that an electronic circuit must be present in order for the device to function as intended.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the light emitting diode of Kapitza et al in the microscope of Nakasato in order to provide for a power saving illumination device.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasoto US 5,262,891 in view of Tandler et al US 6,674,575.

Regarding claim 13, Nakasoto teaches the invention as set forth above but does not teach that the sample support part includes a transparent element, and a diffusion disk provided between the illumination module and the transparent element.

Regarding claim 13, Tandler et al teaches (see Figure 2) that the sample support part includes a transparent element (1), and a diffusion disk (7) provided between the illumination module and the transparent element.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the transparent element and the diffusion disk as taught by Tandler et al in the microscope of Nakasato in order to provide for more uniform illumination of the sample.

12. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891 in view of Schilling et al US 4,565,427.

Regarding claims 14 and 15, Nakasato teaches the invention as set forth above and teaches (see Figure 1) at least one Z drive knob (11) but does not teach that an eccentric cam is mechanically connected to said Z drive knob, wherein the eccentric cam coacts with the base of the microscope stage so that the microscope stage is vertically displaceable or an elastic element that exerts a return force on the microscope stage being joined to the base of the microscope stage and to the stand of the microscope.

Regarding claim 14, Schilling does teach (see Figures 1A, 2) an eccentric cam (11) is mechanically connected to said Z drive knob, wherein the eccentric cam coacts with the base of the microscope stage so that the microscope stage is vertically displaceable. Regarding claim 15, Schilling does teach (see Figures 1A, 2) an elastic element (18) that exerts a return force on the microscope stage being joined to the base of the microscope stage and to the stand of the microscope as shown in Figure 1A.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the eccentric cam and elastic element as taught by Schilling et al in the microscope of Nakasato in order to provide for rapid and easy action adjustment of the microscope stage.

13. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakasato US 5,262,891.

Regarding claim 16, Nakasato teaches the invention as set forth above does not teach that the base of the microscope stage, the light-emitting diode, and an electronic circuit together constitute illumination module and are a preassembled component, and the base, the guide part, and the sample support stage part are adhesively bonded to one another. It would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the base, guide part and sample support stage together since it has been held that making in one piece which has formerly been formed in multiple pieces involves only routine skill in the art. One would have been motivated to bond the base, guide part and sample support stage together in order to permanently and rigidly bond the components together. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)

14. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tandler et al US 6,674,575 in view of Kaczynski et al US 5,315,080.

Regarding claims 11 and 12, Tandler et al teaches the invention as set forth above and regarding claim 12, that the energy source being a battery or rechargeable battery as described in column 2, lines 35-41.

However, Tandler et al does not teach an on/off switch associated with the microscope stage.

Regarding claim 11, Kaczynski et al does teach (see Figures 1, 2) an on/off switch (21) associated with the microscope stage.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the switch as taught by Kaczynski et al in the microscope of Tandler in order to protect the objective lenses and all associated components from damage in the event of an uncontrolled specimen collision as described in column 1, lines 57-68 and column 2, lines 1-5 of Kaczynski et al.

15. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tandler et al US 6,674,575 in view of Schilling et al US 4,565,427.

Regarding claims 14 and 15, Tandler teaches the invention as set forth above but does not teach at least one Z drive knob that an eccentric cam is mechanically connected to said Z drive knob, wherein the eccentric cam coacts with the base of the microscope stage so that the microscope stage is vertically displaceable and in regard to claim 15 does not teach an elastic element that exerts a return force on the microscope stage being joined to the base of the microscope stage and to the stand of the microscope.

Regarding claim 14, Schilling does teach (see Figures 1A, 2) an eccentric cam (11) is mechanically connected to said Z drive knob, wherein the eccentric cam coacts with the base of the microscope stage so that the microscope stage is vertically displaceable. Regarding claim 15, Schilling does teach (see Figures 1A, 2) an elastic

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element (18) that exerts a return force on the microscope stage being joined to the base of the microscope stage and to the stand of the microscope as shown in Figure 1A.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the eccentric cam and elastic element as taught by Schilling et al in the microscope of Tandler in order to provide for rapid and easy action adjustment of the microscope stage.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tandler et al US 6,674,575.

Regarding claim 16, Tandler et al teaches the invention as set forth above does not teach that the base of the microscope stage, the light-emitting diode, and an electronic circuit together constitute illumination module and are a preassembled component, and the base, the guide part, and the sample support stage part are adhesively bonded to one another. It would have been obvious to one having ordinary skill in the art at the time the invention was made to bond the base, guide part and sample support stage of Tandler et al together since it has been held that making in one piece which has formerly been formed in multiple pieces involves only routine skill in the art. One would have been motivated to bond the base, guide part and sample support stage together in order to permanently and rigidly bond the components together. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bloch et al US 6,488,398 teaches a microscope stage as shown

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in Figures 3 and 5. Parker et al US 3,941,452 teaches a microscope stage for a portable microscope comprising a sample support part, a guide part and a base and an illumination module carried by the base as shown in Figure 3.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava:MM
7 December 2004


MARK A. ROBINSON
PRIMARY EXAMINER